UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/086,009	02/27/2002	Alan Rubinstein	3COM-3720 .BCG.US.P	1061

7590 10/26/2005	EXAMINER
WAGNER, MURABITO & HAO LLP	JEAN GILLES, JUDE

ART UNIT	PAPER NUMBER
2143	

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DATE MAILED: 10/26/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)
	10/086,009	RUBINSTEIN ET AL.
	Examiner	Art Unit	
	Jude J. Jean-Gilles	2143	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *12 July 2005*.

2a)☒ This action is **FINAL**.   2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-26* is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-26* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☒ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *27 February 2002* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All   b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☒ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
    Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____.

5)☐ Notice of Informal Patent Application (PTO-152)

6)☐ Other: _____.

DETAILED ACTION

This Action is in regards to the Reply received on 07/12/2005.

Response to Amendment

1.   This office action is responsive to communication filed on 02/27/02. Claimed

Priority is granted from provisional application **60/277593** with a priority filing date:

03/20/01. Claims 1, 8, 15 and 21 and 20 were amended. There are no newly added

claims. Claims 1-26 are pending. Claims 1-26 represent a method and apparatus for an

"secure network outlet for supporting IP device address assigning functionality."

Response to Arguments

2.   Applicant's arguments with respect to claims 1, 8, 15 and 21 have been carefully

considered, but are not deemed fully persuasive. Applicant's arguments are deemed

moot in view of the following ground of rejection as explained here below, necessitated

by Applicant substantial amendment (i.e., a method wherein the said intelligent

hardware is wall-mountable and comprises a user-accessible surface such that a user is

provided direct access to said intelligent hardware) to the claims which significantly

affected the scope thereof.

The dependent claims stand rejected as articulated in the First Office Action and

all objections not addressed in Applicant's response are herein reiterated.

Claim Rejections - 35 USC § 102

3.   The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that

form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless -
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4.   **Claims 1-26** are rejected under 35 U.S.C. 102(b) as being anticipated by Bhatia

et al (Bhatia), U.S. Patent No. 6,028,848).

Regarding claim 1, Bhatia teaches a method for performing device address

assigning functionality in intelligent hardware (5g. 1, item 300,. column 10, lines 10-30),

said method comprising:

receiving a network access request from an electronic device communicatively

coupled to said intelligent hardware (column 4, lines 52-67; column 5, lines 1-10);

transmitting a device address request to a network server communicatively

coupled to said intelligent hardware (column 4, lines 52-67,. column 5, lines 1-35);

receiving a first device address from said network server communicatively

coupled to said intelligent hardware (column 5, lines 10-35); and

assigning a second device address to said electronic device communicatively

coupled to said intelligent hardware (column 5, lines 10-67).

wherein the said intelligent hardware is wall-mountable and comprises a user-

accessible surface such that a user is provided direct access to said intelligent

hardware (fig. 3, items 350, 330).

Regarding claim 2, Bhatia teaches a method as recited in Claim 1 wherein said

intelligent hardware comprises:

a first interface for communicatively coupling said intelligent hardware to

a network, said network comprising said network server (fig. 1, item 305,. column 10,

lines 31-56.);

a second interface for communicatively coupling said intelligent hardware to a

plurality of said electronic devices such that each said electronic device is

communicatively coupled to said network (fig. 1, items 34; column 10,. lines 22-44),

a processor coupled to said first interface and said second interface (5g. 1, items

330,. column 14, lines 15-67); and

a device address retriever coupled to said processor (column 1 7, lines 43-67,.

column 18, lines 1-10).

Regarding claim 3, Bhatia teaches a method as recited in Claim 1 wherein said

first device address and said second device address are an IP addresses (column 12,

lines 1-40).

Regarding claim 4, Bhatia teaches a method as recited in Claim 1 wherein said

network server comprises a DHCP server (column 1 7, lines 42-67; fig. 4B, item 408).

Regarding claim 5, Bhatia teaches a method as recited in claim 1 wherein said

first device address is the same as said second device address (column 12, lines 1-40).

Regarding claim 6, Bhatia teaches a method as recited in Claim 1 wherein said

first device address is a global device address (column 5, lines 15-60; note that the

Public Address of the workstation is the global address of the device).

Regarding claim 7, Bhatia teaches a method as recited in Claim 1 wherein said second device address is a private device address (column 5, lines 15-60; note that the Private Address of the workstation is the private address of the device).

Regarding claim 8, Bhatia teaches a method for performing device address assigning functionality in intelligent hardware (fig. 1, item 30; column 10, lines 10-30), said method comprising:

receiving a network access request from an electronic device communicatively coupled to said intelligent hardware, said intelligent hardware having a first device address (column 4, lines 52-67,. column 5, lines 1-5) wherein the said intelligent hardware is wall-mountable and comprises a user-accessible surface such that a user is provided direct access to said intelligent hardware; and

assigning a second device address to said electronic device communicatively coupled to said intelligent hardware, such that said intelligent hardware eliminates the need for a separate device address assigning server (column 5, lines 10-35,. column 11, lines 64-67,. column 12, lines 1-40).

Regarding claim 15, Bhatia teaches an intelligent device for performing device address assigning functionality comprising:

a wall-mountable housing (fig. 1; item 300Note that this intelligent device is an external MODEM and all external MODEMS are inherently wall-mountable);

a first interface for communicatively coupling said intelligent device to a network (fig. 1, item 305,. column 10, lines 31-56),

a second interface for communicatively coupling said intelligent device to

a plurality of electronic devices such that each said electronic device is

communicatively coupled to said network (fig. 1, items 340,. column 10, lines 22-44)

wherein the said second interface is comprised within a user-accessible surface such

that a user is provided direct access to said intelligent hardware (fig. 1, items

305;column 10, 1-67);

a processor coupled to said first interface and said second interface (fig. 1, items

33) column 14, lines 15-67); and

a device address retriever coupled to said processor for retrieving a first device

address for said intelligent device from a network server of said network and for

assigning a second device address to said electronic device

wherein said first interface, said processor and said device address retriever are

comprised within said wall-mountable housing (fig. 1, items 300, 305, 350, 310, 330;

column 1 7, lines 43-67; column 18, lines 1-44; fig. 3, items 350, 330).

Regarding claim 21, Bhatia teaches an intelligent device for deforming device

address assigning functionality, said intelligent device having a first device address,

said intelligent device comprising :

a first interface for communicatively coupling said intelligent device to a

network (fig. 1, item 305,. column 1 0, lines 31-56);

a second interface for communicatively coupling said intelligent device to

a plurality of electronic devices such that each said electronic device is

communicatively coupled to said network (5g. 1, items 340,. column 10, lines 22-

44) wherein said second interface is comprised within a user-accessible surface such

that a user is provided direct access to said intelligent hardware (fig. 3, items 350);

a processor coupled to said first interface and said second interface (fig. 1, items

330; column 14, lines 15-67); and

a device address assignor coupled to said processor for assigning a second

device address to said electronic device (column 5, lines 10-67).

Wherein said first interface, said second interface, said processor and said

device address retriever are comprised within said wall-mountable housing (fig. 3, items

350, 330).

Regarding claim 9: Claim 9 lists all the same elements of claim 2, but in a

different form. Therefore, the supporting rationale of the rejection to claim 2 applies

equally as well to claim 9.

Regarding claims 10, 16, and 22: Claims 10, 16, and 22 list all the same

elements of claim 3, but in a different form. Therefore, the supporting rationale of the

rejection to claim 3 applies equally as well to claims 10, 16, and 22.

Regarding claims 11, 17, and 23: Claims 11, 17, and 23 list all the same

elements of claim 4, but in a different form. Therefore, the supporting rationale of the

rejection to claim 4 applies equally as well to 11, 17, and 23.

Regarding claims 12, 18, and 24: Claims 12, 18, and 24 list all the same

elements of claim 5, but in a different form. Therefore, the supporting rationale of the

rejection to claim 5 applies equally as well to 12, 18, and 24.

Regarding claims 13, 19, and 25: Claims 13, 19, and 25 list all the same

elements of claim 6, but in a different form. Therefore, the supporting rationale of the

rejection to claim 6 applies equally as well to 13, 19, and 25.

Regarding claims 14, 20, and 26: Claims 14, 20, and 26 list all the same

elements of claim 7, but in a different form. Therefore, the supporting rationale of the

rejection to claim 7 applies equally as well to 14, 20, and 26.

Response to Arguments

5.   Applicant's Request for Reconsideration filed on 07/12/2005 has been carefully

considered but is not deemed fully persuasive. However, because there exists the

likelihood of future presentation of this argument, the Examiner thinks that it is prudent

to address Applicants' main points of contention.

> A. The Bhatia patent fails to disclose or suggest, "receiving a network access
>
> request from an electronic device communicatively coupled to said intelligent
>
> hardware with respect to independent **claims 1, 8, 15,** and **21**".
>
> B. Applicant contends that **claims 1, 8, 15,** and **21** have been amended to
>
> further define an intelligent device that is "wall mountable and comprises a user-
>
> accessible surface to provide direct access to the user.

6.   As to "Point A" it is the position of the Examiner that Bhatia in detail teaches the

limitations of the above mentioned claims and in particular receiving a network access

request from the ISDDN modem that is coupled to the network. [see rejection of claims

1, 8, 15,and 21 above].

7.   As to "Point B", it is the position of the Examiner that Bhatia in detail teaches the

limitations of the above mentioned claims. However, in view of Applicant's

remarks, stating that Bhatia teaches an ISDN LAN modem that may be connected to a

number of workstations and that such LAN modem is located in a wiring closet at some

distance. It is the position of the examiner that the issue of distance is not in the claims.

The issue is whether or not this modem device can be wall-mounted. The answer is

yes.   Furthermore, the analog line interface of fig 3 gives the user direct access to the

device[see rejection of claims 1, 8, 15,and 21 above].

Conclusion

8.   Applicant's amendment necessitated the new ground(s) of rejection presented in

this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP

§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37

CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE

MONTHS from the mailing date of this action. In the event a first reply is filed within

TWO MONTHS of the mailing date of this final action and the advisory action is not

mailed until after the end of the THREE-MONTH shortened statutory period, then the

shortened statutory period will expire on the date the advisory action is mailed, and any

extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

the advisory action. In no event, however, will the statutory period for reply expire later

than SIX MONTHS from the date of this final action.

9.   Any inquiry concerning this communication or earlier communications from

examiner should be directed to Jude Jean-Gilles whose telephone number is (571) 272-

3914. The examiner can normally be reached on Monday-Thursday and every other

Friday from 8:00 AM to 5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, David Wiley, can be reached on (571) 272-3923. The fax phone number for

the organization where this application or proceeding is assigned is 571-273-8300.

Any inquiry of a general nature or relating to the status of this application or

proceeding should be directed to the receptionist whose telephone number is (571) 272-

9000.

Jude Jean-Gilles

Patent Examiner

Art Unit 2143

DAVID WILEY
SUPERVISORY PATENT EXAMINER
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JJG

September 30, 2005